

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 20277
	:	
Thomas M. FUDALI, et al.	:	Confirmation Number: 5122
	:	
Application No.: 10/674,409	:	Tech Center Art Unit: 2629
	:	
Filed: October 01, 2003	:	Examiner: William BODDIE
	:	
For: USER INTERFACE DIAGNOSTIC INSTRUMENT	:	

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellants' Appeal Brief in support of the Notice of Appeal filed January 7, 2010. Please charge the Appeal Brief fee of \$540.00 to Deposit Account 500417.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. 1.17 and 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Michael A. Messina
Registration No. 33,424

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MAM:llg
Facsimile: 202.756.8087
Date: March 8, 2010

**Please recognize our Customer No. 20277 as
our correspondence address.**

TABLE OF CONTENTS

	Page
REAL PARTY IN INTEREST	1
RELATED APPEALS AND INTERFERENCES.....	1
STATUS OF CLAIMS	2
STATUS OF AMENDMENTS	2
SUMMARY OF CLAIMED SUBJECT MATTER	2
ARGUMENT	5
CONCLUSION.....	10
CLAIMS APPENDIX.....	11
EVIDENCE APPENDIX.....	15
RELATED PROCEEDINGS APPENDIX.....	16

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APPEAL BRIEF

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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed January 7, 2010, wherein Appellant appeals from the Primary Examiner's rejection of claims 1-9.

Real Party In Interest

This application is assigned to SNAP-ON INCORPORATED by assignment recorded on February 4, 2005, at Reel 016233, Frame 0203.

Related Appeals and Interferences

Appellants are unaware of any related Appeals or Interferences.

Status of Claims

1. Claims withdrawn: 10-24.

2. Claims pending: 1-9.
3. Claims rejected: 1-9.
4. Claims on appeal: 1-9.

Status of Amendments

There were no amendments proposed after the Final Office Action of August 7, 2009.
All previous amendments have been entered.

Summary of Claimed Subject Matter

Claim 1 is independent. An aspect of the invention, per claim 1, is a computer-readable storage medium for storing instructions for invoking a function of a diagnostic instrument (paragraphs 0020, 0028, and 0037 of the written description). The code, when executed, causes the instrument to display a first navigational menu including at least one display element having a touch sensitive active region therein (paragraph 0044 of the written description), and a graphical representation of functionality invoked via user selection of the display element by user contact with the touch sensitive active region (paragraph 0045 of the written description). The display element and the touch sensitive active region are located on the same surface of a display screen of the diagnostic instrument (paragraphs 0044 and 0045 of the written description, and Fig. 4 of the application).

The code also causes a second navigational menu to be displayed responsive to contact on the touch sensitive active region of the at least one display element (paragraph 0051 of the written description). The second navigational menu includes a selection group related to a test suite of the diagnostic instrument (paragraphs 0052 and 0057 of the written description), and an

instrument identity banner including details of the type and status of the diagnostic instrument (paragraphs 0044 and 0050 of the written description).

Grounds of Rejection To Be Reviewed By Appeal

1. Claims 1-4 and 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,123,243 (Kawasaki) in view of U.S. Patent No. 6,801,849 (Szukala).
2. Claim 5 under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Szukala and further in view of U.S. Patent No. 6,603,494 (Banks).
3. Claim 6 under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Szukala and further in view of U.S. Patent No. 5,598,527 (Debrus).
4. Claim 8 under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Szukala and further in view of U.S. Patent No. 5,859,628 (Ross).
5. Claim 9 under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Szukala and further in view of U.S. Patent No. 7,154,481 (Cross).

Argument

1. THE REJECTION OF CLAIMS 1-4 AND 7 AS BEING UNPATENTABLE OVER KAWASAKI ET AL. IN VIEW OF SZUKALA

The Examiner's Position

The Examiner asserted, at pages 3-5 of the Final Office Action of August 7, 2009 (“the final office action”), that Kawasaki teaches claim 1’s computer-readable storage medium for storing instructions for invoking a function of an instrument; the code, once executed, causing the instrument to display a first navigational menu including at least one display element having a touch sensitive active region therein and a graphical representation of functionality invoked via user selection of the display element by user contact with the touch sensitive active region, the display element and the touch sensitive active region being located on the same surface of a display screen of the diagnostic instrument. The Examiner further asserted Kawasaki teaches an instrument identity banner including details of the type of the diagnostic instrument.

The Examiner admitted Kawasaki does not disclose that the interface is for a diagnostic instrument, as claimed, and also does not disclose the recited second navigational menu, or displaying the status of the instrument.

The Examiner further asserted that Szukala discloses a first navigational menu including at least one display element; a second navigational menu configured to be displayed responsive to contact on the touch sensitive active region of the at least one display element, the second navigational menu including a selection group related to a test suite of the diagnostic instrument; and an instrument identity banner including details of the type and status of the diagnostic instrument.

The Examiner concluded it would have been obvious to use the instrument of Kawasaki as a diagnostic tool and include a second navigational menu as taught by Szukada. The Examiner asserted that the motivation would have been the need for a portable diagnostic device, and the benefit of providing a main menu and submenus to help a user more quickly reach the desired function.

Appellants' Position

The Examiner erroneously contends that both the Szukala and Kawasaki references teach the recited identity banner. The Examiner is improperly interpreting the claim language unreasonably broadly, in an attempt to shoehorn the claim limitations into the references. One skilled in the art would not have considered Szukala or Kawasaki, alone or in combination, to have taught the claimed instrument identity banner.

At pages 2 and 4 of the final office action, the Examiner analogizes Kawasaki's display in Fig. 2 to the recited instrument identity banner, contending that the "Pioneer" logo communicates the *type of instrument*, as claimed. However, the Pioneer logo simply conveys a brand name, not details of a diagnostic instrument type, as claimed. The viewer would not know anything about the instrument's functionality or type by viewing the Pioneer logo, and one skilled in the art would understand this. Further, even if the Pioneer logo is considered an instrument identity banner, it does not meet the limitations of claim 1, because it does not include the status of the instrument, as claimed. If the Examiner is considering the entire display of Fig. 2 of Kawasaki, including the Pioneer logo, the volume buttons, and "Step 18" volume status indicator as an identity banner, the Examiner is interpreting the claim term "banner" unreasonably broadly, since one skilled in the art would not consider an *entire display* a banner.

Rather, a “banner” is typically a small part of a display, as shown in Fig. 4 of the present application (see ref. num. 430) and as commonly understood.

In the Advisory Action of November 17, 2009, the Examiner contends the Applicants are taking an overly narrow view of the term “instrument identity banner” because Kawasaki discloses an indicator of the current mode of the device (i.e., its volume adjustment) and the status of its current mode (its volume level), which are displayed in only a small portion of the display, not the entire display. Appellants disagree, and submit this interpretation is erroneous in view of the claim language, and inconsistent with the Examiner’s statements in the final office action.

It would be improper to interpret the recited “instrument identity banner” broadly enough to read on a display of a volume control and level. There is nothing whatsoever related to the instrument’s *identity* in Kawasaki’s volume control and level display, even if the term “banner” is construed broadly enough to cover the volume display. Considering Kawasaki’s volume control and level display by itself to be the claimed instrument identity banner effectively reads out the words “instrument” and “identity” from the term, since a volume control/level display does not in itself identify an instrument. The Examiner’s interpretation of instrument identity banner as it relates to Kawasaki in the Advisory Action is therefore unreasonably broad.

Moreover, the Advisory Action’s interpretation is inconsistent with that of the final office action, which explicitly stated that Kawasaki’s “Pioneer” logo communicates the type of instrument, as claimed, and its volume level display communicates the status of the instrument, as claimed (final office action at 2). In summary, the final office action considered Kawasaki’s *Pioneer logo and volume display* as parts of the claimed instrument identity banner, while the

Advisory Action seems to have considered the *volume display alone* to be analogous to the claimed instrument identity banner. The Examiner cannot have it both ways! In any event, both of these analogies are erroneous, as discussed immediately herein above, and so cannot support an obviousness rejection.

The Examiner further analogizes Szukala's title bars, such as "Static Info" shown in Fig. 8(a) and "Dynamic Info" shown in Fig. 8(b), to the claimed instrument identity banner, and asserts these titles convey the current type of the diagnostic instrument (final office action at 2, Advisory Action at 2). The Examiner is in error, because none of the title bars shown in Figs. 8(a) to 14(b) of Szukala includes details of an instrument type, as claimed. Szukala's titles refer to information and/or data relating to the *engine under test* (engine model, hours, temperature, etc.), or to a *general kind of test* (i.e., static, dynamic, fuel injector, etc.) not to the type of diagnostic instrument. One skilled in the art would surely understand that title bars referring to static and dynamic information and data relating to an engine or engine test are not the same thing as banners displaying details of the type of a diagnostic instrument, as claimed. The Examiner has no basis for taking the position of the final office action and Advisory Action, unless the customary meaning of the claim language is disregarded, which is not warranted here.

The Examiner also incorrectly analogizes Szukala's display of the term "Working . . ." in Fig. 14(b) to the claimed display in an identity banner of the status of the diagnostic instrument. Although Szukala arguably indicates the status of the instrument, the "Working . . ." indication does not appear in an instrument identity banner with an indication of the type of instrument, as claimed. It appears in the main portion of the display, remote from the title bar (which the Examiner analogizes to the claimed identity banner). The Examiner is interpreting the term

“banner” unreasonably broadly by considering the main display area a banner. One skilled in the art would understand the difference between a major display area and a banner.

Since neither Kawasaki nor Szukala teaches or suggests displaying an instrument identity banner as claimed, any combination of these references, however made, would be missing this claimed feature, and it would not have been obvious to add this feature to any Kawasaki/Szukala combination. Therefore, the rejection of claim 1 was made in error. Consequently, independent claim 1 is patentable, as are claims 2-4 and 7, which depend from claim 1.

2. THE REJECTION OF CLAIM 5 AS BEING UNPATENTABLE OVER KAWASAKI ET AL. IN VIEW OF SZUKALA ET AL AND FURTHER IN VIEW OF BANKS ET AL.

The Examiner's Position

The Examiner acknowledged that Kawasaki and Szukala both fail to teach including a textual description of functionality with a graphic, as required by claim 5. However, the Examiner asserted Banks teaches this limitation, and it would have been obvious to a skilled artisan to provide Banks’ textual descriptions alongside the graphics of Kawasaki and Szukala (final office action at 6-7).

Appellants’ Position

The additional cited Banks reference does not teach or suggest displaying the claimed instrument identity banner of claim 1, from which claim 5 depends, missing from Kawasaki and Szukala. Thus, no combination of Kawasaki, Szukala, and Banks, however made, would render the invention of claim 5 obvious.

Consequently, claim 5 is patentable.

3. THE REJECTION OF CLAIM 6 AS BEING UNPATENTABLE OVER KAWASAKI ET AL. IN VIEW OF SZUKALA ET AL AND FURTHER IN VIEW OF DEBRUS ET AL

The Examiner's Position

The Examiner acknowledged that Kawasaki and Szukala both fail to teach that a touch sensitive active region comprises an approximately circular shape with a diameter of at least 3/8 inch, as required by claim 6. However, the Examiner asserted Debrus teaches this limitation, and it would have been obvious to a skilled artisan to provide Debrus' circular shaped region in the devices of Kawasaki and Szukala (final office action at 7-8).

Appellants' Position

The additional cited Debrus reference does not teach or suggest displaying the claimed instrument identity banner of claim 1, from which claim 6 depends, missing from Kawasaki and Szukala. Thus, no combination of Kawasaki, Szukala, and Debrus, however made, would render the invention of claim 6 obvious.

Consequently, claim 6 is patentable.

4. THE REJECTION OF CLAIM 8 AS BEING UNPATENTABLE OVER KAWASAKI ET AL. IN VIEW OF SZUKALA ET AL AND FURTHER IN VIEW OF ROSS ET AL.

The Examiner's Position

The Examiner acknowledged that Kawasaki and Szukala both fail to teach that a touch sensitive active region comprises at least 1/10 of the screen area, as required by claim 8. However, the Examiner asserted Ross teaches this limitation, and it would have been obvious to

a skilled artisan to provide Ross' display area in the devices of Kawasaki and Szukala (final office action at 8).

Appellants' Position

The additional cited Ross reference does not teach or suggest displaying the claimed instrument identity banner of claim 1, from which claim 8 depends, missing from Kawasaki and Szukala. Thus, no combination of Kawasaki, Szukala, and Ross, however made, would render the invention of claim 8 obvious.

Consequently, claim 8 is patentable.

5. THE REJECTION OF CLAIM 9 AS BEING UNPATENTABLE OVER KAWASAKI ET AL. IN VIEW OF SZUKALA ET AL AND FURTHER IN VIEW OF CROSS ET AL.

The Examiner's Position

The Examiner acknowledged that Kawasaki and Szukala both fail to teach first and second navigational menus displayed on a touch screen device sized and positioned to be responsive to a gloved finger, as required by claim 9. However, the Examiner asserted Cross teaches this limitation, and it would have been obvious to a skilled artisan to size the touch screen of the devices of Kawasaki and Szukala in the manner of Cross (final office action at 9).

Appellants' Position

The additional cited Cross reference does not teach or suggest displaying the claimed instrument identity banner of claim 1, from which claim 9 depends, missing from Kawasaki and Szukala. Thus, no combination of Kawasaki, Szukala, and Cross, however made, would render the invention of claim 9 obvious.

Consequently, claim 9 is patentable.

Conclusion

Based upon the arguments submitted supra, Appellants respectfully submit that the Examiner's rejections under 35 U.S.C. §103 are not legally viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections of claims 1-9.

For all the foregoing reasons, Appellants respectfully submit that the grounds of rejection of the claims on appeal are in error and should be reversed.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Michael A. Messina

Registration No. 33,424

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MAM:lg
Facsimile: 202.756.8087
Date: March 8, 2010

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as our correspondence address.**

CLAIMS APPENDIX

1. A computer-readable storage medium for storing instructions for invoking a function of a diagnostic instrument, the code, once executed, causing the instrument to display:

a first navigational menu including at least one display element, the at least one display element having a touch sensitive active region therein and a graphical representation of functionality invoked via user selection of the display element by user contact with the touch sensitive active region, the display element and the touch sensitive active region being located on the same surface of a display screen of the diagnostic instrument;

a second navigational menu configured to be displayed responsive to contact on the touch sensitive active region of the at least one display element, the second navigational menu including a selection group related to a test suite of the diagnostic instrument; and

an instrument identity banner including details of the type and status of the diagnostic instrument.

2. The medium of claim 1, wherein the selection group includes a plurality of display elements, each of the plurality of display elements having a touch sensitive active region to enable user selection of the plurality of display elements.

3. The medium of claim 1, wherein the selection group includes fewer than ten display elements to permit discrete touch sensitive selection of each of the fewer than ten display elements.

4. The medium of claim 1, wherein the first navigational menu includes at least six display elements, each of the at least six display elements having a discrete touch sensitive active region sized to permit finger tip selection.

5. The medium of claim 1, wherein the at least one display element comprises a textual description of functionality invoked by user selection of the display element.

6. The medium of claim 1, wherein the touch sensitive active region comprises an approximately circular shape with a diameter of at least $\frac{3}{8}$ inch.

7. The medium of claim 1, wherein the touch sensitive active region comprises an area having a polygonal shape of at least $\frac{1}{4}$ square inch.

8. The medium of claim 1, wherein the touch sensitive active region comprises an area of at least $\frac{1}{10}$ that of the screen area.

9. The medium of claim 1, wherein the first and the second navigational menus are displayed on a touch screen device sized and positioned so as to be responsive to a gloved finger.

EVIDENCE APPENDIX

Not applicable.

RELATED PROCEEDINGS APPENDIX

Appellants are unaware of any related proceedings.